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Ian Carr

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EXAMINER

GRAY, PHILLIP A

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/827,434
Filing Date: April 20, 2004
Appellant(s): CARR ET AL.

Ian Carr
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/29/2010 appealing from the Office action mailed 7/6/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: 10/419,934 is under appeal and assigned Appeal No. 2010-001315.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-3, 5-21 are pending.

Claims 1-3, 5-14, 16-18, and 20 are rejected.

Claims 15, 19, 21 are allowable if written in independent form, including all of the limitations of the base claim and any intervening claims to which they depend.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

3,073,307	Stevens	1-1963
4,900,309	Netherton et al.	2-1990
6,436,086	Newby et al.	8-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 10, 11, 17, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevens (U.S. Patent 3,073,307). Stevens discloses a cylindrical body (10) having an opening (near 28), neck (11) with cover (24), weakened joint (near 19), finger grasp means (wing type structure 26), lock mechanism first portion and second portion (at 14) and needle hub assembly (near 13) comprising a base with double ended needle (12) and catch (14) and distal section (hub portion near 19 in cover 24) and notch (near line 3).

Concerning the claim language of the finger grasp means coupled to said cover "at a desired location along the length of said cover to amplify the torque force applied by a user to said cover when the user applies a predetermined torque to said finger grasp means to rotate said cover relative to said body to separate said cover from said neck at said weakened joint, said predetermined torque if applied anywhere along the length of said cover where to said finger grasp means is not coupled would fail to separate from said neck", it is examiners position that Stevens discloses this. Stevens discloses finger grasp means (26) coupled to the cover (24) along a length "at a desired

location” (as shown in figures 1-4). It is examiner's position that Steven's finger grasp means would also carry out the as specified in the new amendments to the claim of “amplify the torque” where there are finger grasp means and places where the finger grasp means are not (i.e. top uppermost portion of the cover) would fail to separate the cover from the neck since torque was not properly applied (or “amplified”).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 8, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens. Stevens discloses the claimed invention except for the torque required to separate the cover being 60 ounce inches of torque or less than 60 ounce inches of

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torque. It would have been obvious to one having ordinary skill in the art at the time the invention was made to required to separate the cover being 60 ounce inches of toque or less then 60 ounce inches of torque, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 2, 3, 14, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Netherton et al. (U.S. Patent 4, 900, 309). Netherton discloses a safety shield wing nut (as in figure 1-4) for attachment to a cover (18) with a bore (22), slots (28), wings (40) on collar (36), and housing (34).

Stevens discloses the claimed invention except for the wing nut. Netherton teaches that it is known to use a safety shield wing nut as set forth in paragraphs at columns 2-4 to provide a safe means to separate and join the needle and cover while preventing needle sticks. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Stevens with safety wing nut as taught by Netherton, since such a modification would provide the system with a safety wing nut for providing a safe means to separate and join the needle and cover while preventing needle sticks.

Claims 9, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Newby et al. (U.S. Patent 6,436,086). Stevens discloses the claimed invention except for the attached rotatable collar and housing with hooks.

[*Reference B*] teaches that it is known to use an attached rotatable collar and housing

with hooks as set forth in paragraphs at columns 4-6 to provide a safety cover after the device has been used and initial seal cover broken. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Stevens with attached rotatable collar and housing with hooks as taught by Newby since such a modification would provide the system with attached rotatable collar and housing with hooks for providing a safety cover after the device has been used and initial seal cover broken.

Allowable Subject Matter

Claims 15, 19, 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

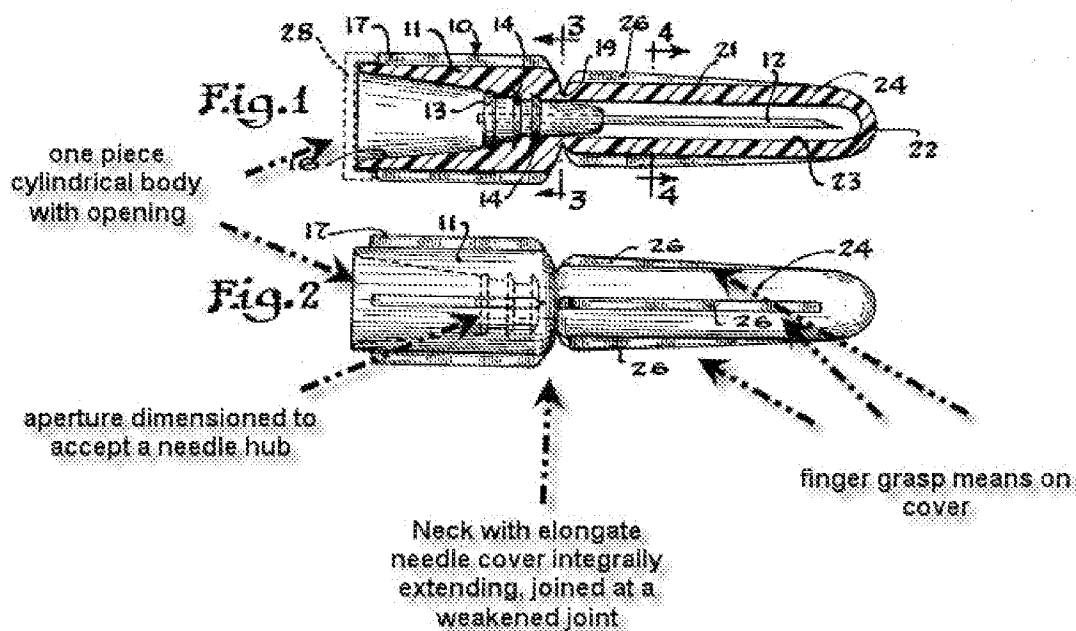
(10) Response to Argument

Applicant's first argument is that Stevens fails to disclose a "one piece cylindrical body and an "opening at one end through which a fluid storage tube is insert able. Further applicant argues that a hypodermic syringe is not a "fluid storage tube".

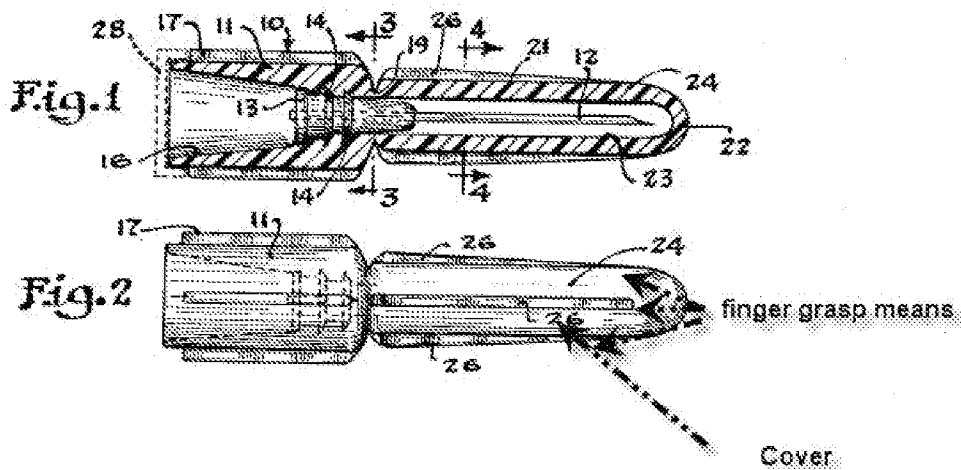
Examiner is of the position that Stevens discloses all claimed structures and these structures are fully capable of all functions of the applicant's claims. Examiners has provided a marked up figure below of what he is considering the "one piece cylindrical body" and the "opening at one end through which a fluid storage tube is insertable". Examiner is reading the "opening at one end" to be the claimed structure

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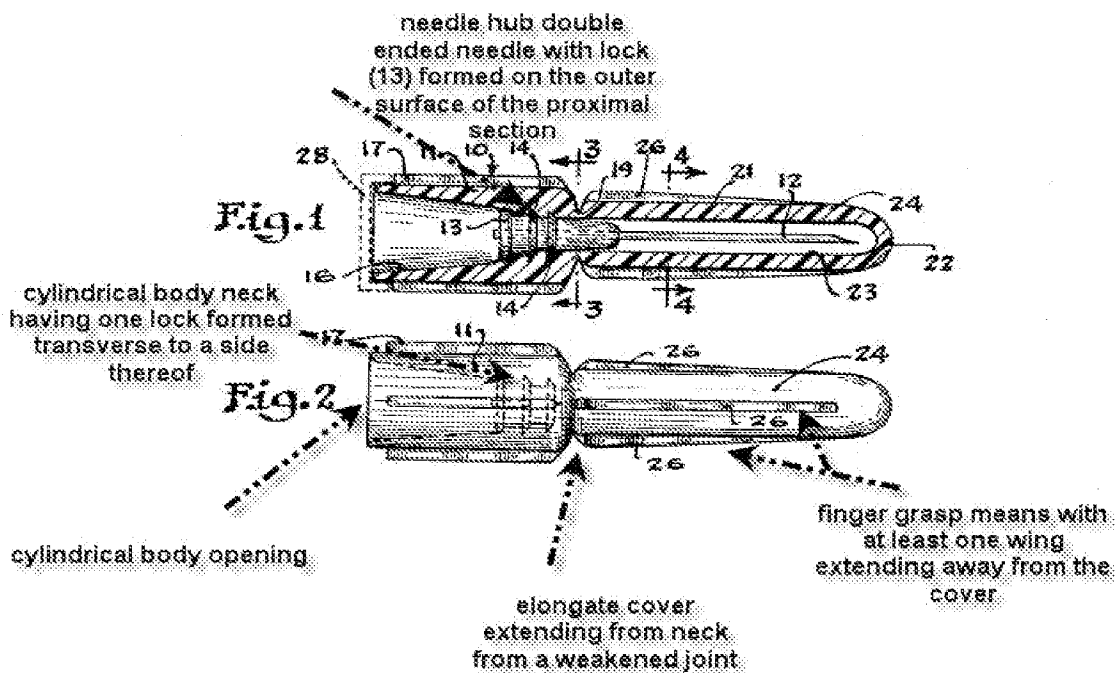
(see figure below) and the "which a fluid storage tube is insertable..." to be a functional limitation. It is examiners position that a hypodermic syringe, which would be connected to this Stevens device, is "a fluid storage tube" (since it holds a medicament), further this is a functional limitation and only requires the ability to perform that function, the claims do not positively claim the fluid storage tube. All claimed structures are disclosed in Stevens and are capable of performing the claimed functional limitations of the applicant's claims.



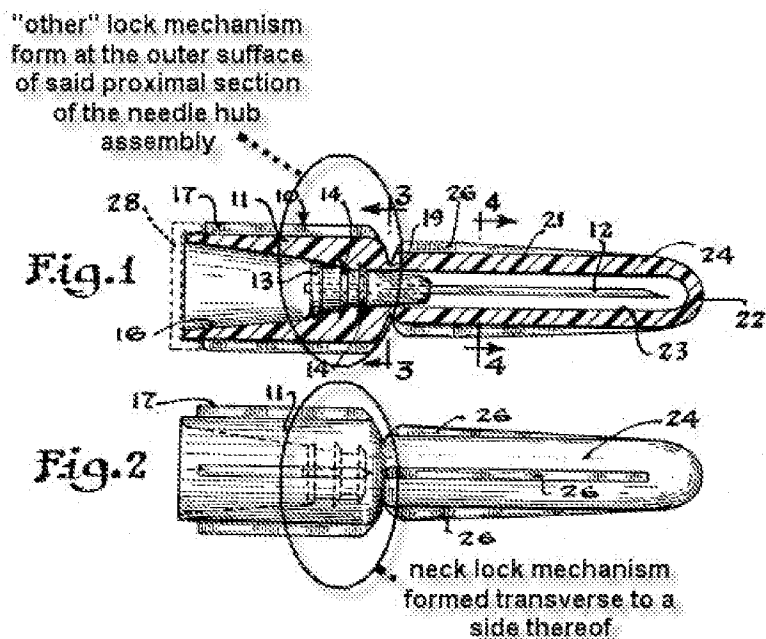
Applicants further argue that the Stevens's finger grasp means are couple to the needle sheath 21 and not the cover. Examiner is of the position that Stevens finger grasp means are on the cover. Examiner has provided a marked up figure which shows what examiner is considering the cover and there the finger grasp means are. See below.



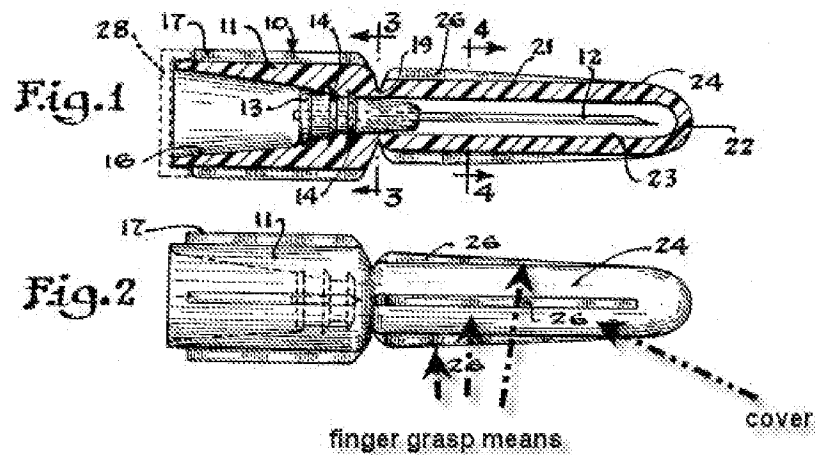
Applicants further argue that the structures of claim 11 are not disclosed in Stevens. Examiner disagrees and has provided a marked up drawing of Stevens which shows the claimed structures.



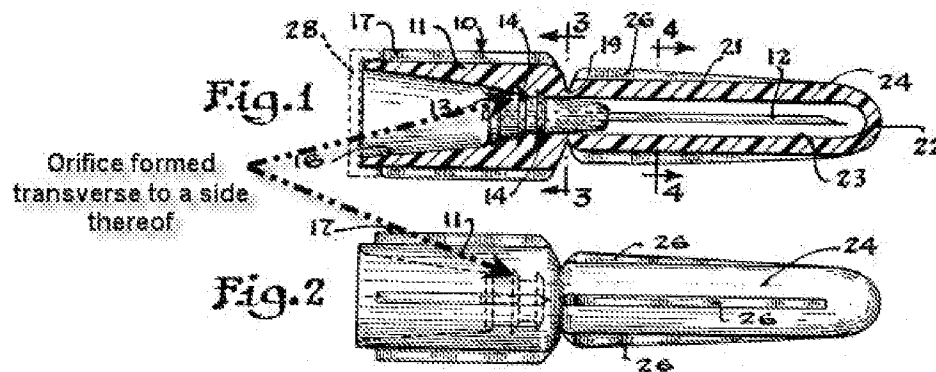
Concerning the “neck having one lock” formed “transverse to a side thereof” see locking element structures on the cylindrical body of Stevens (piece 11 near 14) and the “other lock” on the needle hub 13 near 14 complimentary with the cylindrical body lock. See figure below.



Applicant argues that Stevens's finger grasp means are not fixedly mounted to a desired location along the length of the elongate cover. Examiner disagrees and shows in a marked up figure the finger grasp means fixedly mounted to a desired location along the length of the elongate cover.

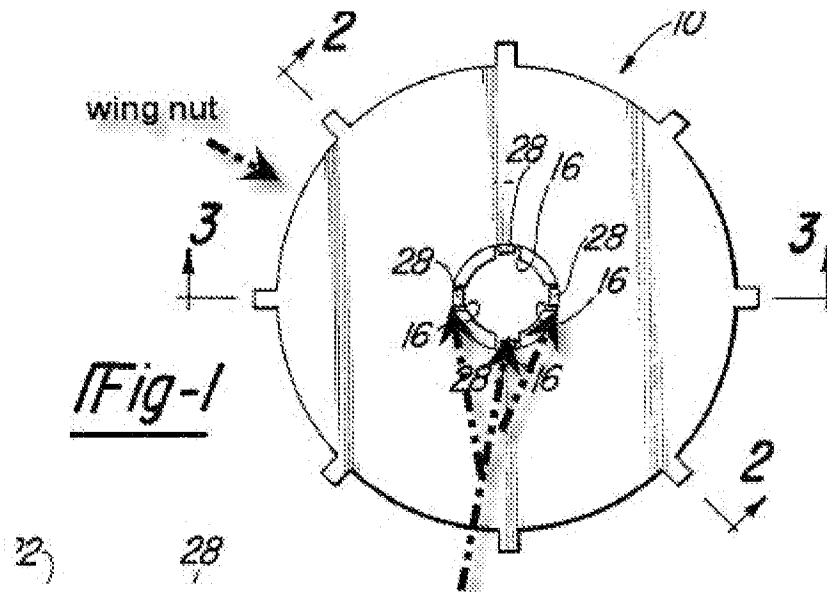


Applicant further argues that Stevens does not anticipate claim 18 since there is no "orifice formed transverse to the needle hub. . Examiner disagrees and shows in a marked up figure below. Note area near 14 on the one piece cylindrical body 11.

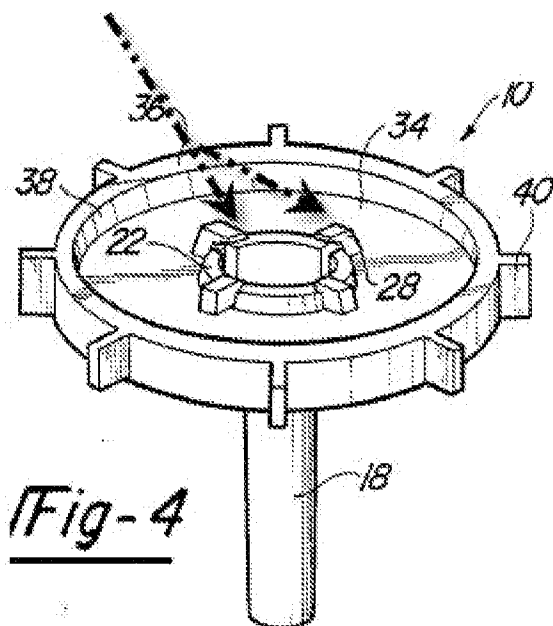


Applicant argues that the catch of the needle hub snappingly latching to a side orifice at said neck (as in claim 6) is not disclosed in Stevens. Again Examiner disagrees. See marked up figure above which shows the needle hub "snappingly" latching to the side orifices of the cylindrical body at the distal side near the neck.

Applicant argues that Netherton device is not a wing nut and fails to disclose a plurality of slots along the inner circumferential surface that ride in corresponding ribs along the length of a needle cover. Examiner disagrees and provides an marked up figure of Netherton's wing nut structure. Further note Netherton tabs 20 on needle cover interact with the slots of the wing nut structure.



plurality of slots along
 the inner circumference
 that ride on
 corresponding ribs
 along the length of a
 needle cover



Applicant further argues that one not combine Stevens in view of Netherton since Netherton is a shield device and Stevens is a needle hub assembly that requires its needle cover broken off. Examiner is of the position that this is an appropriate combination since Netherton solves a problem of handling and manipulating a needle cover and Stevens has a cover which requires handling and manipulating.

Applicants argue that Netherton wing nut fails to show a “leg”, or a ring with a plurality of wings on the outer wall and slots on the inner wall (or that Netherton is a wingnut). It is examiners position that 40 of Netherton is a wingnut (as shown above) and has legs or wings (40) on the outer wall (near 38) and slots near 28 are slots on the inner wall. See figures above.

It is examiners position that The elements disclosed in the prior art of record (particularly Stevens and Netherton), are fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended claims, as currently written, and the rejection is made and proper. See rejection discussion below.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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/Phillip Gray/

Examiner, Art Unit 3767

Conferees:

/KEVIN C. SIRMONS/

Supervisory Patent Examiner, Art Unit 3767

/Thomas J Sweet/

Supervisory Patent Examiner, Art Unit 3779